

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Jackson et al. Confirmation No.: 3708

Serial No.: 10/577,696; National Stage of International Application No. PCT/US2004/035636 Art Unit: To be assigned

Filed: October 27, 2004 Examiner: To be assigned

For: METHOD OF DESIGNING siRNAs FOR GENE SILENCING Attorney Docket No: 9301-244-999

**REQUEST TO WITHDRAW NOTIFICATION OF DEFECTIVE
RESPONSE**

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants have received a Notification of Defective Response dated August 22, 2007 from the United States Patent and Trademark Office ("USPTO") in connection with the above-identified application. The Notification of Defective Response asserts that Applicants have not submitted a copy of the Sequence Listing in computer readable form (CRF") as required by 37 C.F.R. § 1.821, and that Applicants have failed to comply with the requirements of 37 C.F.R. §§1.821-1.825. Applicants respectfully submit that such assertions in the Notification of Defective Response are erroneous.

On March 12, 2007, Applicants filed a Response to Notification of Missing Requirements and Preliminary Amendment ("Response") in connection with the above-identified application, which included a copy 1 and copy 2 of a Sequence Listing on compact disks and a copy of the Sequence Listing in CRF, accompanied by a Transmittal of Sequence Listing containing the statements required by 37 C.F.R. §§ 1.821-1.825. An amendment specifically directing the entry of the Sequence Listing into the specification was made in the Response. During a phone conversation on September 13, 2007 with Stephanie Wang, a representative of Applicants, Examiner Anita D. Johnson acknowledged that the Response and the Transmittal of Sequence Listing had been received by and were shown in the records at the USPTO; however, Examiner Johnson stated that copies of the Sequence Listing were missing from the records of the USPTO. Examiner Johnson further acknowledged that an

amendment specifically directing the entry of the Sequence Listing into the specification was found in the Response filed on March 12, 2007. In the same phone conversation, Examiner Johnson also acknowledged that the USPTO had received the following items, which were not among the items listed as received by the USPTO on the Notification of Defective Response:

- (i) executed Power of Attorney by Assignee, with attached copy of assignment;
- (ii) Information Disclosure Statement;
- (iii) List of References Cited; and
- (iv) copies of References B01-B02 and C01-C59.

The above-identified documents were filed by Applicants on March 12, 2007 accompanying the Response.

As evidence of the filing of the Sequence Listing (copy 1 and copy 2) on compact disks and in CRF, the Transmittal of Sequence Listing, and Response, all on March 12, 2007, Applicants enclose herewith: 1) a copy of the return postcard as filed on March 12, 2007, listing the foregoing documents and the Express Mail Label No. EV 686 164 566 US; 2) a copy of the same return postcard stamped by the USPTO with a filing date of March 12, 2007; 3) a copy of the Express Mail Label for EV 686 164 566 US, showing a "Date Accepted" of March 12, 2007 and stamped by the Post Office with a date of March 12, 2007; 4) a copy of the Response as filed on March 12, 2007, bearing the Express Mail Label No. EV 686 164 566 US; and 5) a copy of the Transmittal of Sequence Listing as filed on March 12, 2007, bearing the same Express Mail Label No. Also enclosed herewith are copy 1 and copy 2 of the Sequence Listing on compact disks and in Computer Readable Form, identical to those previously submitted on March 12, 2007.

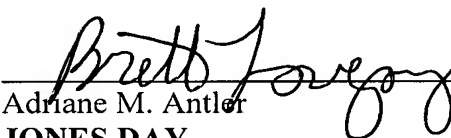
The above evidence shows that the documents filed by Applicants on March 12, 2007 fully satisfied the requirements of 37 C.F.R. §§1.821-1.825, and that the issuance of the Notification of Defective Response was in error. Accordingly, Applicants respectfully request that the Notification of Defective Response be withdrawn by the USPTO. Applicants further submit that the filing of the instant Request to Withdraw Notification of Defective Response should *not* result in any reduction of patent term under 37 C.F.R. § 1.704, since it was USPTO error, and not a failure by Applicants to engage in reasonable efforts to conclude prosecution of the application, that necessitated the filing of the present communication. In

particular, the above remarks and evidence show that the Response to filed on March 12, 2007 did **not** have any omission, and thus does not qualify under 37 C.F.R. § 1.704(c)7.

Applicants further request that the USPTO acknowledge receipt of the documents listed in items (i)-(iv) above.

Respectfully submitted,

Date: September 21, 2007

 ^{42,813}
Adriane M. Antler 32,605
JONES DAY (Reg. No.)
222 East 41st Street
New York, New York 10017-6702
Phone: (212) 326-3939

Enclosures



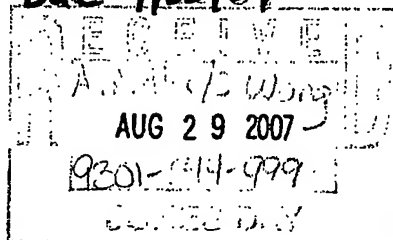
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U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/577,696	Aimee L. Jackson	9301-244-999

20583
JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

**Response to Notification
of Defective Response
Due 9/22/07**



INTERNATIONAL APPLICATION NO.	
PCT/US04/35636	
LA. FILING DATE	PRIORITY DATE
10/27/2004	10/27/2003

CONFIRMATION NO. 3708

371 FORMALITIES LETTER



OC000000025480796

Date Mailed: 08/22/2007

NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495)

- Priority Document
- Copy of the International Application filed on 04/27/2006
- Copy of the International Search Report filed on 04/27/2006
- Preliminary Amendments filed on 04/27/2006
- Oath or Declaration filed on 03/12/2007
- Request for Immediate Examination filed on 04/27/2006
- U.S. Basic National Fees filed on 04/27/2006
- Priority Documents filed on 04/27/2006
- Specification filed on 04/27/2006
- Claims filed on 04/27/2006
- Abstracts filed on 04/27/2006
- Drawings filed on 04/27/2006

Applicant's response filed 03/12/2007 is hereby acknowledged. The following requirements set forth in the NOTIFICATION of MISSING REQUIREMENTS mailed 01/11/2007 have not been completed.

- This application clearly fails to comply with the requirements of 37 CFR. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing", an initial paper or compact disc copy of the "Sequence Listing", as well as an amendment specifically directing its entry into the application. Applicant must also provide a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821

(e) may be submitted in lieu of a new CRF.

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- For Rules Interpretation, call (571) 272-0951
- For Patentin Software Program Help, call Patent EBC at 1-866-217-9197 or directly at 703-305-3028 / 703-308-6845 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.
- Send e-mail correspondence for Patentin Software Program Help @ ebc@uspto.gov

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.
<https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

ANITA D JOHNSON

Telephone: (703) 308-9140 EXT 226

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/577,696	PCT/US04/35636	9301-244-999

COPY

Express Mail No: EV 686 164 566 US

Date Mailed: March 12, 2007

Serial No.: 10/577,696

Filed: October 27, 2004

Inventor: Jackson et al.

For METHOD OF DESIGNING siRNAs FOR GENE SILENCING

The stamp of the Patent Office hereon may be taken as an acknowledgment of the date stamped of the following:

- (x) Response to Notification of Missing Requirements and Preliminary Amendment (submitted in duplicate);
- (x) Copy of Notification of Missing Requirements (2 pp.);
- (x) Executed Declaration for Non-provisional Patent Application;
- (x) Executed Power of Attorney by Assignee, executed on behalf of Rosetta Inpharmatics LLC (Assignee), with attached copy of assignment;
- (x) Transmittal of Sequence Listing (in duplicate), and Copy 1 and Copy 2 of Sequence Listing on compact discs and Sequence Listing in Computer Readable Form;
- (x) Information Disclosure Statement;
- (x) List of References Cited; and
- (x) Copies of References B01-B02 and C01-C59.

File No. 9301-244-999

Sender: AMA/SXW

Express Mail No: **EY 686 164 566 US**

Date Mailed: March 12, 2007

Serial No.: 10/577,696

Filed: October 27, 2004

Inventor: Jackson et al.

For **METHOD OF DESIGNING siRNAs FOR GENE SILENCING**

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File No. 9301-244-999

Sender: AMA/SXW

1AP15 Rec'd PCT/PTO 12 MAR 2007



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